REMARKS

Claims 1 through 112 are in the application. Claims 1, 2, 4, 7, 15-25, 27, 28, 32, 35-37, 41, 42, 44, 46, 47, 51, 52, 54-63, 65-68, 70, 72, 75, 76, 80, 81, 85, 86, 89, 90, 93-97, 99, 101, 102, 104, and 106 are currently amended and claims 3, 5, 6, 8-14, 26, 29, 30, 31, 33, 34, 38-40, 43, 45, 48-50, 53, 64, 69, 71, 73, 74, 77-79, 82-84, 87, 88, 91, 92, 98, 100, 103, 105, and 107-112 remain unchanged from the original versions thereof. Claims 1, 15, 35, 41, 55, 75, and 89 are the independent claims herein.

No new matter is added to the application as a result of the amendments submitted herewith.

Reconsideration and further examination are respectfully requested.

Claim Rejections Under 35 USC § 103(a)

Claims 1-9, 15-17, 20-49, 55-57, 60-83, 89-91, and 94-112 were rejected as being unpatentable over Intacta (a collection of prior art cited in PTO-892, Items U-W). This rejection is respectfully traversed.

Regarding the rejection of claims 1-9, 15-17, 20-49, 55-57, 60-83, 89-91, and 94-112, the Office Action states at page 6 that the cited and relied upon Intacta U-W disclose various aspects of Applicants' claimed invention as indicated in paragraph 2, pages 2-6 thereof. The Office Action alleges that Intacta U-W disclose "a user computer communicating a decoded INTACTA.CODE image to a provider's web site to receive item information from the provider's web site". The Office Action further states that it "would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Intacta to disclose the user emailing the image to a provider's web site since one of ordinary skill in the art would ascertain the web site server being capable of decoding the image and retrieving item information for the user."

Applicants respectfully submit that the cited and relied upon Intacta U-W do not disclose that for which they are cited and relied upon for disclosing, and that the Office's reasoning for modifying Intacta to support the rejection under 35 USC 103(a) is improper.

Independent claims 1, 15, 35, 41, 55, 75, and 89 are currently amended to clarify that which is claimed by Applicants. Claims 1, 35, 41, and 75 relate to transmitting an image of an item identifier to a remote location for processing of the image and, in response to processing of the transmitted image, receiving item information associated with an item identified by the item identifier. Claims 15, 55 and 89 relate to receiving, at a remote location, an image of an item identifier transmitted from a local location.

Support for the amendments submitted herewith may be found in the published specification, at least at paragraph [0025], wherein Applicants disclose an image of an item identifier captured by, for example, a digital camera may be transmitted to a remote device for processing of the image. Applicants also disclose, at least at paragraph [0027] of the published specification, receiving an image identifier in operation S21 transmitted from, for example, a device according to operation S12 of process 10. It is clear from the specification that the transmitting device of operation 12 is a local device. Clearly, the claimed methods, system, medium, and apparatuses relate to an image of an item identifier that is captured locally, transmitted to a remote location for processing, and received at the remote location via a transmission from the local location for making a determination of item information associated with an item associated with the item identifier.

Furthermore, Applicants also disclose that the claimed invention, in some embodiments, may reduce a need to decode an item identifier locally. (See paragraph [0011])

Furthermore, Applicants respectfully submit that the cited and relied upon Intacta U-W disclose a method for encoding data (e.g., sound, image, multimedia, and application data files) in a INTACTA.CODE™ format and printing the encoded data in a dot pattern on, for example, newsprint paper. Intacta U-W disclose a user, such a newspaper reader, installing a viewing program on their computer and scanning the INTACTA.CODE™ formated dot pattern from a

newspaper using a general-use scanner. In all of the examples provided in Intacta U-W, the scanning and <u>decoding</u> of the INTACTA.CODE™ formatted dot pattern is performed locally by a user using a software decoder installed on the user's local computer. (See Intacta U, page 2, paragraph 4) Intacta U discloses distributing the necessary decoding software free of charge to customers so that the customers can install it on their (local) computer. As stated in Intacta V, readers capture and decode the encoded data using the software installed on their (local) computer. (See Intacta V, page 2, paragraph 3) Each and every example provided by Intacta U-W discloses a user scanning and decoding the encoded dot pattern at their local computer. Thus, it is clear that Intacta U-W disclose local scanning and local decoding of an encoded dot pattern.

Intacta W discloses possibly transmitting <u>encoded</u> an INTACTA.CODE™ formatted dot pattern as a bitmap graphic, email attachments, fax, or printout. (See Intacta W, page 2, paragraph 8) That is, the encoded INTACTA.CODE™ data may be delivered to, for example, a reader recipient in a number ways. However, Intacta W only discloses transmitting the <u>encoded</u> dot pattern (i.e., image) as a bitmap graphic, email attachments, fax, or printout, not decoded data. In accordance with the disclosed method of capturing or scanning the encoded INTACTA.CODE™ image, it appears that after the image is delivered as a bitmap graphic, email attachments, fax, or printout, the image must be scanned (i.e., captured) and decoded by the user locally. That is, while Intacta W discloses delivering the encoded image to a user in a variety of ways, the image is both scanned and decoded by the user locally.

Contrary to the disclosure of Intacta U-W, Applicants claimed invention relates to transmitting an image of an item identifier to a remote location for processing of the image and in response to processing of the transmitted image receiving item information associated with an item identified by the item identifier, and receiving, at a remote location, an image of an item identifier transmitted from a local location.

Also, the cited references provide no support for the Office Action's allegation that Intacta U-W discloses "a user computer communicating a decoded INTACTA.CODE™ image to a provider's web site to receive item information from the provider's web site". While this

statement is not fully understood, Applicants emphasize that Intacta U-W discloses "[C]ode boxes can...take readers to Web sites in a fashion similar to small scannable bar codes that other firms have developed." (See Intacta W, page 2, last paragraph – page 3, line 2) That is, Intacta appears to disclose an encoded INTACTA.CODE™ image may contain a link to a web site that when scanned and decoded by a user directs the user (e.g., user's web browser) to a link associated with the encoded image. Thus, the Office Action's assertion that Intacta U-W discloses "a user computer communicating a decoded INTACTA.CODE™ image to a provider's web site to receive item information from the provider's web site" is not supported by the cited and relied upon references.

Moreover, Applicants respectfully submit that it would be erroneous and improper to interpret Incata U-W as even suggesting transmitting an image captured at a local location to a remote location for processing since such an interpretation or modification of Intacta U-W would teach away from a fundamental objective of Intacta U-W which is to deliver an encoded image to a user that scans the image using a general purpose scanner and decodes the image using software installed on the user's local computer. See MPEP §2143.01 A primary objective of Intacta U-W is to deliver data in a robust format (e.g., encoded INTACTA.CODE™ image) directly to a user so that the user can capture and decode the encoded data locally. Modifying Intacta U-W such that the user emails an INTACTA.CODE™ encoded image to a data provider's web site for decoding teaches away from the explicit teaching of Incata U-W. There is no disclosure, suggestion, or motivation provided in Incata U-W for the claimed transmitting of the image to a remote location for processing thereof, and the claimed receiving at a remote location an image of an item identifier transmitted from a local location.

Regarding Intacta U-W, Applicants note that the press release referred to as Intacta U by the Office clearly and unambiguously states that it "contains forward-looking statements regarding the anticipated results, and benefits to, Intacta of the technology alliance with Fujitsu. Actual results could differ materially from those anticipated in the statements" and that the uncertainty of actual results may be based on "the risks involved with developing software solutions and integrating them with third-party software and services" (emphasis added, Intacta

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U, page 3) Clearly, the Intacta U press release provides a warning regarding the truthfulness and veracity of the anticipatory (i.e., not actually realized and/or fact supported) statements provided therein. Neither the press release nor the Office Action provides a distinction between the statements that are supported by fact (if any) and the merely forward-looking, anticipatory statements. The cited and relied upon Intacta V is also a press release and appears to also include forward-looking statements. Applicants do not admit to the feasibility of the statements provided in Intacta U-W.

Accordingly, Applicants submit that the Office Actions' reliance on reference(s) that admit to containing non-factual statements is improper under 35 USC 103(a) where the Office Action relies on the reference(s) for a factual determination of obviousness. This is particularly true in the present case where neither the cited and relied upon references nor the Office Action provides a distinction between factual statements (if any) and anticipatory (i.e., admitted non-factual) statements in the cited and relied upon reference. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the 35 USC 103(a) rejection on the basis that the rejection is improper.

Accordingly, Applicants respectfully submit that independent claims 1, 15, 35, 41, 55, 75, and 89 are patentable over the cited and relied upon Incata U-W under 35 USC 103(a) for at least the reasons stated hereinabove. Dependent claims 2-9, 16, 20-34, 36-40, 42-49, 56-57, 60-74, 76-83, 90-91, and 94-112 depend from claims 1, 15, 35, 41, 55, 75, and 89. Applicants respectfully submit that the dependent claims are patentable over the cited and relied upon Intacta U-W for at least the same reasons stated above regarding claims 1, 15, 35, 41, 55, 75, and 89. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1-9, 15-17, 20-49, 55-57, 60-83, 89-91, and 94-112, and the allowance of same.

Claims 10-14, 50-54, and 84-88 were rejected as being unpatentable over Intacta (a collection of prior art cited in PTO-892, Items: U-W), in view of Official Notice (regarding promotional offers), further in view of Business Wire (PTO-892, Item: WWW Hereinafter referred to as "BW"). This rejection is respectfully traversed.

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The rejection of claims 10-14, 50-54, and 84-88 relies on the reasoning provided in the 35 USC 103(a) rejection of the independent claims discussed hereinabove. Inasmuch as Applicants have clearly shown that the cited and relied upon Incata U-W fail to disclose that for which they are cited and relied upon for disclosing, Applicants respectfully submit that all of dependent claims 10-14, 50-54, and 84-88 are also patentable over the cited and relied upon Intacta U-W, Official Notice, and BW combination of references.

Accordingly, Applicants respectfully submit that dependent claims 10-14, 50-54, and 84-88 are patentable over the cited and relied upon Incata U-W, Official Notice, and BW combination under 35 USC 103(a). Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 10-14, 50-54, and 84-88, and the allowance of same.

Claims 18, 19, 58, 59, 92, and 93 were rejected as being unpatentable over Intacta (a collection of prior art cited in PTO-892, Items: U-W), in view of PR Newswire (PTO-892, Item: X, hereinafter referred to as "PRN1"). This rejection is respectfully traversed.

The rejection of claims 18, 19, 58, 59, 92, and 93 relies on the reasoning provided in the 35 USC 103(a) rejection of the independent claims discussed hereinabove. Since Applicants have clearly shown that the cited and relied upon Incata U-W fail to disclose that for which they are cited and relied upon for disclosing, Applicants respectfully submit that all of dependent claims 18, 19, 58, 59, 92, and 93 are also patentable over the cited and relied upon Intacta U-W and PRN1 combination of references.

Accordingly, Applicants respectfully submit that dependent claims 18, 19, 58, 59, 92, and 93 are patentable over the cited and relied upon Incata U-W and PRN1 under 35 USC 103(a). Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 10-14, 50-54, and 84-88, and the allowance of same.

CONCLUSION

Accordingly, Applicants respectfully request allowance of pending claims 1-112. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-5985.

Respectfully submitted,

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